

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-5, 9-26 and 30-38 are pending in this application. Independent Claims 1, 16, 32-35 and 38 are amended by the present amendment. Support for the amended claims can be found in the original specification, claims and drawings.¹ No new matter is added.

In the Final Office Action of July 20, 2006 (hereinafter, the "Final Action"), Claims 1-5, 9-24 and 30-35 were rejected under 35 U.S.C. 102(e) as anticipated by Sullivan et al. (U.S. Patent No. 6,477,531, herein "Sullivan"); Claims 1-5, 9-24 and 30-35 were rejected under 35 U.S.C. 103(a) as unpatentable over Grewal et al. (U.S. Patent No. 6,691,159, herein "Grewal") in view of Meyer et al. (U.S. Patent No. 6,601,190, herein "Meyer") and Rangan (U.S. Patent No. 6,412,073); Claims 25-26 and 36-37 were rejected under 35 U.S.C. 103(a) as unpatentable over Grewal, Meyer, Rangan, and House et al. (U.S. Patent No. 6,119,247, hereinafter House); Claim 38 was rejected under 35 U.S.C. 103(a) as unpatentable over Grewal, Meyer, Rangan and Hayward et al. (U.S. Patent No. 6,629,134, herein "Hayward"); Claims 25, 26 and 36, 37 were rejected under 35 U.S.C. 103(a) as unpatentable over Sullivan and House; and Claim 38 was rejected under 35 U.S.C. 103 (a) as unpatentable over Sullivan in further view Hayward.

Claims 1-5, 9-24 and 30-35 were rejected under 35 U.S.C. 102(e) as anticipated by Sullivan. Applicants respectfully traverse this assertion, as independent Claims 1, 16 and 32-35 recite novel features clearly not taught or rendered obvious by the applied reference.

Amended independent Claim 1 recites, in part, an online support method that gives online support to eliminate a problem arising in a device, comprising the steps of:

¹ E.g., specification, p. 20, lines 12-29, and Fig. 6.

(a) providing a user of the device with a specific form that enables the user to input and transmit information with regard to the problem;

(b) providing the user of the device with support information, which is prepared in advance for elimination of the problem, *prior to said step (a)*,

wherein the specific form comprises a first part that asks the user to input first information generally required for analysis of the problem, and a second part that enables the user to input arbitrary information;

(c) obtaining browsing record information, which represents a user's browsing record of the support information, in addition to information input into the specific form; and

(d) transmitting the information input into the specific form and the browsing record information attached to the specific form to an online support operator.

Independent Claims 16, 32-35 and 38, while directed to alternative statutory embodiments, recite substantially similar features. Accordingly, the remarks presented below are applicable to each of independent Claims 1, 16, 32-35 and 38.

Turning to the applied reference, Sullivan describes a method for automated technical support in a computer network having a client machine and at least one server. The method allows a user to fill out entries on a form (e.g., Figs. 5-6) in a self-help session to gather diagnostic data. If this step is unsuccessful, the session may enter a live-help session, during which a support technician can obtain the information generated based on the self-help session to diagnose a problem.²

Sullivan, however, fails to teach or suggest providing the user of the device with support information *prior to* providing a user of the device with a specific form that enables the user to input and transmit information with regard to the problem, and transmitting the information input into the specific form *and the browsing record information attached to the specific form to an online support operator*, as recited in independent Claim 1.

² Sullivan, Abstract.

In addressing the “form” feature recited in the pending independent claims, the Final Action relies on Fig. 5 (ref. num. 66 and 68) and Fig. 6 of Sullivan. However, the interface depicted in Figs. 5 and 6 of Sullivan is provided before any support information is accessed by the user, and these interfaces are used to allow the user to either launch into a Web browser based self-help routine or enter a live-help system. Thus, the interfaces depicted in Figs. 5 and 6 of Sullivan are not provided *after* providing the user of the device with support information. Instead, this interface is a way to allow the user to launch into the support information that may be subsequently provided.

Further, in the case that the user chooses to enter the live-help session, the current problem, input via the interface shown in Fig. 6, is provided to the live-help system (e.g., a support engineer (SE)). However, when the user chooses the live-help option, the Web browser self-help system is never launched and no user browser record is created. Thus, no browser information could possibly be forwarded to the SE to assist in the diagnosis of a problem. Therefore, not only is the interface of Fig. 6 provided before any support information is provided, but the *browsing record information could not be attached to the specific form and transmitted to an online support operator*, because no browsing record information has yet been created.

The Advisory Action of November 7, 2006, asserts that the “concept of providing information in advance and then escalating to online support is not reflected in the claims.” However, Applicants respectfully traverse this assertion as Claim 1 clearly recites a step (a) of “providing a user of the device with a specific form...,” and a step (b) of “providing the user of the device with support information *prior to said step (a)*.” Thus, Claim 1 clearly recites that the support information is provided *prior to* providing the specific form. As noted above, Sullivan is deficient in this regard as the interfaces shown in Figs. 5 and 6 are provided before any self-help or live-help options are explored by the user.

Therefore, Sullivan fails to teach or suggest providing the user of the device with support information *prior to* providing a user of the device with a specific form that enables the user to input and transmit information with regard to the problem, and *transmitting the information input into the specific form and the browsing record information attached to the specific form to an online support operator*, as recited in independent Claim 1.

Claims 25, 26 and 36, 37 were rejected under 35 U.S.C. 103(a) as unpatentable over Sullivan and House, and Claim 38 was rejected under 35 U.S.C. 103 (a) as unpatentable over Sullivan in further view Hayward.

However, as discussed above, Sullivan fails to teach or suggest the above differentiated features recited in independent Claims 1, 16, 32-35 and 38. Likewise, neither House nor Hayward remedy this deficiency, and therefore, none of the cited references, neither alone, nor in combination, teach or suggest Applicants Claims 25, 26 and 36-38, which include the above distinguished limitations by virtue of independent recitation or dependency. Therefore, the Final Action fails to provide a *prima facie* case of obviousness with regard to any of these claims.

Accordingly, Applicants respectfully request that the rejection of Claims 25, 26 and 36-38 under 35 U.S.C. 103, in view of the above noted references, be withdrawn.

Claims 1-5, 9-24 and 30-35 were rejected under 35 U.S.C. 103(a) as unpatentable over Grewal in view of Meyer and Rangan; and independent Claim 38 was rejected under 35 U.S.C. 103(a) as unpatentable over Grewal, Meyer, Rangan and Hayward. Applicants respectfully traverse these rejections, as there is no motivation to combine the cited references, and even if combined, the combination of references fails to teach or suggest all the elements recited in the pending claims.

The Advisory Action appears to side-step the required showing of motivation from the cited references. In this regard, the Advisory Action fails to specifically address the

teachings of the references, simply stating that Applicant's argument that there is no motivation to combine the references is "erroneous because it neglects all the teachings and known techniques available to a web programmer of ordinary skill at the time of the applicant's invention and completely discounts the abilities and intellect of programmers to combine these related techniques."³ With this statement, the Advisory Action makes a broad generalization regarding the ability of web programmers without specifically stating why one of ordinary skill in the art would be motivated to combine the cited references.

In this regard, the PTO has been told this and again by the courts that merely establishing that something was "known" does not establish motivation to use this "known" element in place of an element used in another reference.

See In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) as follows:

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). [Emphasis added.]

Further, the Advisory Action does not specifically address the previously presented arguments pointing out a lack of motivation to combine the cited references. A person of ordinary skill in the art would not combine Grewal, Meyer, and Rangan. The disclosures of Rangan, Grewal, and Meyer do not provide sufficient disclosure of a motivation for transmitting both browsing record information and the claimed specific form.

³ Advisory Action, p. 4.

In rebutting this argument, the Final Action states only that the combination of Grewal, Meyer, and Rangan is proper because “they all relate to data collection techniques via the internet.”⁴ However, simply because the references relate to data collection techniques, such a finding is not sufficient to show that there is motivation to combine the references.

The Final Action states that a person of ordinary skill in the art would combine Rangan with Grewal and Meyer because “user’s browsing records are usually stored on a user’s PC.”⁵ This is not a motivation to combine references as it only states a possibility about where browsing records could be stored. Storing browsing records on a user’s PC does not suggest the desirability as to why downloading or uploading bookmarks of Rangan should be combined with Grewal and Meyer.

Further, Rangan does not describe the tracking of browsing records, but instead is directed to managing bookmarks on a user’s PC. As is known to one of ordinary skill in the art, bookmarks typically require a user to tag a specific Website so that the website may be easily accessed at a later time. These bookmarks do not indicate browsing records, but instead indicate these favorite Websites that are tagged by a user. Further, in the context of an on-line support system, it would not be useful to transmit a user’s bookmarks to a person who is assisting in solving a support question. This is because the bookmarks likely include additional unrelated website URLs, and also typically only indicate a root URL and do not show the specific navigational steps performed by a user in attempting to solve a specific problem. It is not likely that a user goes to the trouble to bookmark every step taken in a browsing session to solve a problem so as to create a “browsing record,” but only bookmarks a particularly useful URL, as noted above. Therefore, one would not be motivated to

⁴ Final Action, p. 12.

⁵ Id., p. 6.

combine Rangan with Grewal or Meyer, because there is no additional benefit in transmitting Bookmarks in either of the Grewal or Meyer systems.

Furthermore, Applicants respectfully submit that a person of ordinary skill in the art would not be motivated to combine Grewal and Meyer. Grewal specifically discloses problem solving through use of a chat room. Meyer only discloses problem solving by sending email to obtain user support. Grewal teaches away from using a form and discloses that forms are cumbersome, impersonal, and time consuming.⁶ Furthermore, Meyer teaches away from service personnel speaking directly with customers because problems with the operation of computers are often complex.⁷ Therefore, one of ordinary skill in the art clearly would not be motivated to combine two references that disparage one another by expressly teaching that the methods used to communicate with user support in each are not sufficient.

"A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). To this end, "disclosures in the references that diverge from and teach away from the invention cannot be disregarded", Phillips Petroleum Company v. U.S. Steel Corp., 9 USPQ2d 1461 (Fed. Cir. 1989).

Accordingly, Applicants respectfully submit that a person of ordinary skill in the art would not combine Grewal and Meyer.

In effect, the outstanding rejection does little more than attempt to show that parts of the inventive combination of Claim 1 were individually known in other arts and to suggest that such a showing is all that is necessary to establish a valid case of *prima face* obviousness. The PTO reviewing court reviewed such a rationale and dismissed it in *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) as follows:

⁶ Grewal, col. 1, lines 22-29.

⁷ Meyer, col. 1, lines 15-22.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. [emphasis added.]

There has been no such showing of those required reasons made in the final rejection.

In view of the above-noted distinctions, Applicants respectfully submit that Claim 1 (and dependent Claims 2-5 and 9-15) patentably distinguishes over Grewal, Meyer, and Rangan, taken alone or in proper combination. Applicants respectfully submit that independent Claims 16, 32-35, and 38 (and dependent Claims 17-31, 36, and 37) patentably distinguish over Grewal, Meyer, Rangan, House, and Hayward taken alone or in proper combination, for at least the same reasons as amended Claim 1.

Furthermore, assuming *arguendo* that the above noted combination is proper, Applicants submit that none of the applied references, neither alone, nor in combination, teach or suggest all the elements recited in the pending independent claims.

Claim 1 recites, *inter alia*, "wherein ***the specific form comprises a first part that asks the user to input first information generally required for analysis of the problem, and a second part that enables the user to input arbitrary information with regard to the problem.***" In rebutting previously presented arguments directed to this claimed feature, the Final Action cites Grewal, and states that "the Web page of Figure 4 is a first part of the form

and the textual dialogue box 212 is a second part of a form. Nowhere has the applicant limited a form to a single website or CGI program.”⁸

However, independent Claim 1 clearly recites that *the specific form... comprises a first part... and a second part*. As depicted at Fig. 10, and as would be obvious to one of ordinary skill in the art, the phrase “*the specific form*” clearly indicates the use of a single questionnaire to which information is input. The website at Fig. 4 of Grewal is not a form, but is instead a website with links allowing a user to navigate through a series of web pages. Further, the textual dialog box merely displays one box that displays a textual interchange between an expert and the user, and can not reasonably be interpreted as being combined with the website at Fig. 4 to be considered *a specific form*. Thus, Grewal fails to teach or suggest *a specific form comprising a first part that asks the user to input first information generally required for analysis of the problem, and a second part that enables the user to input arbitrary information with regard to the problem*, as recited in independent Claim 1.

Further, Meyer and Rangan do not cure the above-noted deficiency in Grewal. The form disclosed in Meyer does not disclose or suggest the claimed two-part form. Meyer only discloses sending an email in a form to obtain user support with one field.⁹ Rangan is not directed toward obtaining user support and does not disclose or suggest a two-part form as described in Claim 1.

Moreover, Claim 1 also recites, *inter alia*, “obtaining browsing record information, which represents a user's browsing record of the support information, in addition to information input into the specific form,” and “transmitting the browsing record information and the information input into the specific form to an online support operator.” The Final Action again relies on Rangan to disclose this element of Claim 1.

⁸ Final Action, p. 12.

⁹ Meyer, Fig. 2.

In addressing arguments related to the above noted feature, the Final Action states that Rangan “is relied upon to show that the uploading of browsing information is a well known concept but is not relied upon to show specifically on-line support information.”¹⁰ (emphasis added)

Specifically, the portion of Rangan cited to in the Final Action merely discloses managing bookmarks. At col. 8, lines 41-51, Rangan describes how bookmarks may be downloaded onto the same user’s local browser or uploaded to the user’s homepage. Claim 1 clearly describes that the browsing record represents a user record of ***browsing support information***. As admitted in the Final Action, Rangan does not teach or suggest that the bookmarks are a record of browsing ***support information***, and the Final Action fails to cite any references to remedy this admitted deficiency.

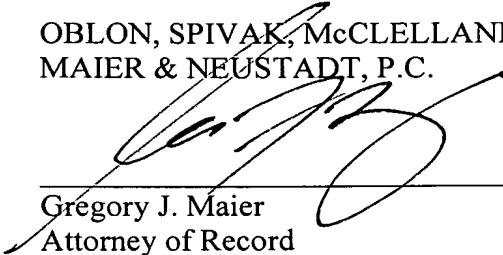
Therefore, none of the cited references, neither alone, nor in combination, teach or suggest “obtaining browsing record information, which represents a user’s browsing record of the support information, in addition to information input into the specific form,” and “transmitting the browsing record information and the information input into the specific form to an online support operator,” as recited in independent Claim 1.

¹⁰ Final Action, p. 12.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1-5, 9-26 and 30-38, is definite and patentably distinguishing over the prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

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